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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/091,444	03/07/2002	Gholam A. Peyman	43440	2636
1609	7590	06/24/2004	EXAMINER	
ROYLANCE, ABRAMS, BERDO & GOODMAN, L.L.P.			WOO, JULIAN W	
1300 19TH STREET, N.W.			ART UNIT	
SUITE 600			PAPER NUMBER	
WASHINGTON,, DC 20036			3731	

DATE MAILED: 06/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

**Application No.**

10/091,444

**Applicant(s)**

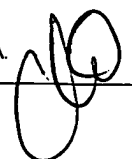
PEYMAN, GHOLAM A.

**Examiner**

Julian W. Woo

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 18 June 2002.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-41 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 7-22, 35-37 is/are allowed.
- 6) ☒ Claim(s) 1, 2, 4-6, 23, 28, 29, 31, 33, 34, 38-41 is/are rejected.
- 7) ☒ Claim(s) 3, 24-27, 30 and 32 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5/28/02</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Claim Objections***

1. Claims 9-11 are objected to because of the informality, which can be corrected as follows: In line 3 of each of these claims, "have" should be replaced by –having–. Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 5 and 28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. With respect to claim 5, "said plurality of blanks" lacks antecedent basis. With respect to claim 28, line 7, "the surface of the cornea" lacks antecedent basis, and it is not certain whether or not the surface is one of the corneal surfaces cited.

### ***Double Patenting***

4. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

5. Claims 1 and 5 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 6,702,807.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim implanting a blank or positioning an implant in a cornea and removing or ablating at least a section or portion of the blank or implant.

6. Claim 23 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 1 of U.S. Patent No. 5,919,185.

Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim a method for modifying the curvature of a cornea.

Although the patent does not claim the step of repositioning a flap or layer of the cornea, so that the inlay is positioned between first and second corneal surfaces; it would have been obvious to one having ordinary skill in the art at the time the invention was made to perform such a step in order to check the fit of the flap or layer of cornea over an implanted inlay or blank that has been ablated or requires further ablation.

7. Claims 38 and 40 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of U.S. Patent No. 6,197,019. Although the conflicting claims are not identical, they are not patentably distinct from each other because they claim a blank having first and second sections or portions adjacent to each other or a second section overlying a first section.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 1, 2, 4, 6, 29, 31, 33, 34, 38, 39, and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Silvestrini (5,824,086). Silvestrini discloses, in figures 10-12 and 15A-15F and in col. 10, lines 20-56, a method for modifying the curvature of a live cornea and a blank for correcting refractive error of a live cornea, where the method includes implanting a blank or inlay having a plurality of sections (e.g., 950, 952, 846, 848) at small incisions and implanting an additional section of the blank or inlay within the cornea, where the blank is ring-shaped (950, 952), where first and second sections or inlays form about half a blank and are concentric, where the cornea is separated into first and second corneal surfaces (e.g., at entry slit 840) or flaps, and where removal of a section of blank is performed at a small incision.

***Allowable Subject Matter***

10. Claims 7-22 and 35-37 are allowed.

11. The following is an examiner's statement of reasons for allowance: None of the prior art of record, alone or in combination, discloses a method for correcting the refractive error in a cornea, where, inter alia, an inlay is positioned on the surface of cornea, ablated, and removed from the cornea, where the cornea is then separated into first and second corneal surfaces, and where the inlay is positioned adjacent at least

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one of the first and corneal surfaces. The prior art of record also does not disclose a method, where, inter alia, the cornea is separated into first and second corneal surfaces, where an inlay is positioned adjacent at least one of the first and second corneal surfaces, measuring the refractive error in the eye, altering the refractive properties of the inlay, and repositioning the inlay adjacent at least one of the first and second corneal surfaces. Also, the prior art of record does not disclose a method where, inter alia, the cornea is separated into first and second corneal surfaces to form a flap, where the flap is moved to position a first inlay adjacent at least one of the first and second corneal surfaces and to position a second inlay adjacent the first inlay.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

12. Claims 3, 24-27, 30, and 32 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

13. Claim 28 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action.

14. The following is a statement of reasons for the indication of allowable subject matter: None of the prior art of record, alone or in combination, a method for modifying the curvature of a live cornea, where the method includes, inter alia, implanting a blank having a plurality of sections, where a first section of the blank has an opening for

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implanting a second section within the opening. The prior art of record also does not disclose a method where, inter alia, the cornea is separated into first and second corneal surfaces to form a flap, where the flap is moved to position and ablate an inlay located adjacent to at least one of the first and second corneal surfaces, where the inlay has a first surface and a convex, flat, toric, or concave second surface. The prior art of record does not disclose a method, where, inter alia, first and second inlays are implanted within a live cornea, where at least one of the inlays is ablated, and where the second inlay overlies a portion of the first inlay.

As allowable subject matter has been indicated, applicant's reply must either comply with all formal requirements or specifically traverse each requirement not complied with. See 37 CFR 1.111(b) and MPEP § 707.07(a).

### ***Conclusion***

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian W. Woo whose telephone number is (703) 308-0421. The examiner can normally be reached Mon.-Fri., 7:00 AM to 3:00 PM Eastern Time, alternate Fridays off.

General inquiries relating to the status of this application should be directed to the Group receptionist at (703) 308-0858. The official FAX number is (703) 872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR.

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Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink that reads "Julian W. Woo". The signature is written in a cursive, flowing style.

Julian W. Woo  
Primary Examiner

June 22, 2004